

## **REMARKS**

By this amendment, Applicants have added dependent claim 37. No new subject matter has been added. Claims 12-17 and 28-37 are currently pending.

### **Restriction Requirement**

Applicants respectfully traverse this restriction as being improper at least for the reasons discussed below. To comply with 37 CFR 1.143, however, Applicants elect the claims of Group II (claims 12-17 and 35-36) drawn to a grinding machine with an anvil.

### **Reasons for Traverse of Restriction**

Applicants note that the basis for restriction requires a two-part analysis. "To support a requirement for restriction between combination and subcombination, both two-way distinctiveness and reasons for insisting on restriction are necessary." MPEP 806.05(c), (underlining added).

Without acquiescing to the merits of whether two-way distinctiveness exists, Applicants respectfully note that reasons for insisting on the restriction have not been provided, and that the Restriction Requirement is therefore improper.

"Reasons for insisting on restriction are necessary, i.e., there should be a serious search burden as evidenced by separate classification, status or field of search." MPEP 806.05(c). "The Examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required." Thus the examiner must show by appropriate explanation one of the following: A) separate classification; B) a separate status in the art when they are classifiable together; C) different field of search.

#### **A) Separate Classification**

Each of Group I and Group II claims are classified in class 241. There is no separate classification.

#### **B) Separate Status in the Art**

This basis requires the Examiner to show that each invention has formed a separate subject for inventive effort. To show that each invention has formed a separate subject for inventive effort, the Examiner must show a recognition of separate inventive effort by inventors. MPEP 808.02. The examiner has provided no evidence of separate inventive efforts by the

inventors, and accordingly has failed to meet the evidentiary requirement that each invention has formed a separate subject for inventive effort.

C) Different Field of Search

It is respectfully submitted that the Examiner is not required to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention, as both claims 12 and 28 relate to an anvil having a wedge-shaped portion that is positioned in a particular orientation relative to a drum. To the contrary, Applicants submit that the field of search is the same for both of claims 12 and 28. The Examiner has provided no rationale or evidence to the contrary.

The Examiner has provided no evidence that a "serious search burden" exists to warrant a restriction requirement. The present restriction requirement is therefore improper.

Moreover, "[w]here the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are not directed to distinct invention; rather they are different definitions of the same disclose subject matter, varying in breadth or scope of the definition." MPEP 806.03.

There is only a *single* embodiment disclosed in the Figures of the present application. Further, essential characteristics describing the one embodiment are not directed to distinct inventions, but instead are only different definitions of the same disclosed subject matter. In particular, each of claims 12 and 28 recite an anvil having a wedge-shaped portion. Each of claims 12 and 28 also defines the location and/or orientation of the wedge portion of the anvil in relation to a grinding drum. Each claim has a different definition of the same disclose subject matter, i.e., the location/orientation of the wedge portion of the anvil relative to the drum.

A restriction between claims 12 and 28 therefore should not be required.

**New Claim 37**

Claims 12-17 and 35-36 have been elected in a traversed restriction requirement. Claim 37 depends upon claim 12. Accordingly, Applicants submit that claim 37 falls with the group of elected claims (Group II).

In light of the above, Applicants respectfully submit that the present restriction is improper and request withdrawal of the restriction prior to further examination of the claims. It is also respectfully submitted that each of the presently pending claims (claims 12-17 and 28-37) is in condition for allowance and notification to that effect is requested.

The Examiner is urged to contact the undersigned attorney at 612.371.5340 with any questions or concerns.



Date: Feb. 3, 2006

Respectfully submitted,

MERCHANT & GOULD P.C.  
P.O. Box 2903  
Minneapolis, Minnesota 55402-0903  
(612) 332-5300

A handwritten signature in cursive script, appearing to read "Karen A. Fitzsimmons", written over a horizontal line.

Karen A. Fitzsimmons  
Reg. No. 50,470  
KAF:cjc